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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/733,755 | 12/12/2003 | Gabi Koerner | 028987.52902US | 8733 |
| 23911 | 7590 | 10/03/2005 | | |
| CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300 | | | EXAMINER SHAFFER, RICKY D | |
| | | | ART UNIT 2872 | PAPER NUMBER |

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/733,755 | KOERNER ET AL | |
| | Examiner | Art Unit | |
| | Ricky D. Shafer | 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2-10, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/12/03 & 5/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Group II (claims 11-15) in the reply filed on 08/11/2005 is acknowledged. The traversal is on the ground(s) that the inventions are sufficiently related that there would be no undue burden to examine the non-elected inventions along with the elected invention. This is not found persuasive because the restriction requirement set forth in the communication mailed on 07/26/2005 is based on the claimed structural differences between the various inventions and not on their similarities. Continued search and examination of claims to a non-elected invention having substantially different structural limitations is a prima facie showing of burden. Applicant may overcome the requirement for restriction by presenting an allowable linking claim or by providing a clear admission on the record that the claim(s) drawn to a given non-elected invention is not patentably distinct from the elected invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 2-10, 16 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 08/11/2005.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation of a motor vehicle, and the claim also recites a sport car type which is the narrower statement of the range/limitation.

Regarding claims 14 and 15, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al ('577).

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To the extent the claim is definite, Lang et al discloses an outside rear-view mirror for a motor vehicle comprising a housing (105) accommodating a mirror glass plate (110,111) is connected with a carrying device (103) having supporting arms (101), wherein the carrying device is supported on a body of the passenger car, wherein the carrying device and the housing are produced separately from one another, free ends of the supporting arms of the carrying device projecting into the housing and being connected with carrying elements (107,151) of the housing. Note figures 10-12 along with the associated description thereof.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boddy ('385).

To the extent the claims are definite, Boddy discloses an outside rear-view mirror assembly for a passenger car comprising a mirror housing (14), a mirror plate (12) supported in the mirror housing, a carrying device (16) including supporting arms (18) attachable with the housing, said carrying device being attachable in use to a body part of the passenger car, wherein the mirror housing and carrying device are formed of different materials (see column 2, lines 16-31), and wherein the free ends of the supporting arms project into the mirror housing and are connected with carrying elements (30) of the mirror housing, wherein the housing is made of a plastic material (acrylic-styrene-acrylonitrile (ASA)) and the carrying device consists of a metal

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(stainless steel or aluminum), note figures 1-3 along with the associated description thereof, except for explicitly stating that the mirror plate comprise a mirror glass plate.

It is well known to manufacture mirrors of a glass material in the same field of endeavor for the purpose of obtaining a mirror glass plate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mirror plate of Boddy to include a mirror glass plate, as is commonly used and employed in the mirror, in order to reflective images to a driver of a vehicle.

9. Claims 1 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su ('325).

To the extent the claims are definite, Su discloses an outside rear-view mirror assembly for a passenger car comprising a mirror housing (1) having a mirror plate supported in the mirror housing and a carrying device (2) including supporting arms (the projections) attachable with the housing, said carrying device being attachable in use to a body part of the passenger car, wherein the free ends of the supporting arms project into the mirror housing and are connected with carrying elements (the holes and/or threaded holes which receive element 5) of the mirror housing, and wherein each supporting arm penetrates an opening in the housing by means of a collar, and the housing rests in the area of the opening on a shoulder bounding the collar, note Fig. 3 along with the associated description thereof, except for explicitly stating that the mirror plate comprises a mirror glass plate and that the mirror housing and carrying device are formed from different materials.

It is well known to manufacture mirrors of a glass material in the same field of endeavor for the purpose of obtaining a mirror glass plate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mirror plate of Su to include a mirror glass plate, as is commonly used and employed in the mirror, in order to reflective images to a driver of a vehicle.

It is well known to manufacture mirror housings of a plastic material in the same field of endeavor for the purpose of obtaining a light weight, corrosion resistance mirror assembly.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mirror housing of Su to include a plastic mirror housing, as is commonly used and employed in the mirror, in order to obtain a light weight, corrosion resistance mirror assembly.

It is well known to manufacture mirror brackets of a metal material in the same field of endeavor for the purpose of obtaining a strong, durable supporting device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mirror bracket of Su to include a metal bracket, as is commonly used and employed in the mirror, in order to obtain a strong, durable supporting device.

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference characters P1, P2 and P3, shown in Fig. 3, lack a proper written description. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the

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sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

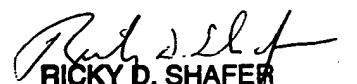
11. Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 15 fails to further limit the subject matter of claim 14 due to the fact claim 15 is identical to claim 14.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

September 27, 2005


RICKY D. SHAFER
PATENT EXAMINER
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